

REMARKS

Claims 1-18 are currently pending in the above-identified patent application. Claims 6, 9, 10, 15, and 18 have been amended. No new matter has been added by these changes.

In the subject Examiner's Action, claims 1-3, 6-12, 15-18 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 6-9, 11, 13-16, 18, 20, 21 of copending Patent Application No. 10/731,191 (hereinafter, '191) in view of U.S. Patent No. 5,864,659 to Kini. The Examiner continued that claims 1-18 of the above-identified application are anticipated by claims 1, 2, 4, 6-9, 11, 13-16, 18, 20, 21/ '191 in that claims 1, 2, 4, 6-9, 11, 13-16, 18, 20, 21/ '191 contain all of the limitations of claims 1-18 of the above-identified application, that claims 1-18 of the above-identified application therefore are not patently distinct from the earlier patent claims, and as such are unpatentable for obvious-type double patenting. The Examiner stated further that while limitations of the claims of '191 are broader than the claims of the instant application, the language and the disclosure of '191 indicate that the limitation of claims of the above-identified application are merely a subset of '191, and that these differences are not sufficient to render the claims patentably distinct.

Claims 4, 5, 13, 14 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/731,191 in view of U.S. Patent No. 5,864,659 to Kini as applied above and further in view of U.S. Patent No. 5,305,013 to Daniels.

The Examiner stated that is a provisional obviousness-type double patenting rejection although a notice of allowance was mailed for '191, and that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint

research agreement. Effective January 1, 1994, the Examiner continued that a registered attorney or agent of record may sign a terminal disclaimer.

In response to both provisional obviousness-type double patenting rejections applicant is filing a Terminal Disclaimer herewith executed by applicant's attorney, without traverse.

Claims 9, 18 were objected to because the Examiner stated that "said at least one indicator device" is understood to refer to "at least one indicator device of said plurality of indicator devices". Applicant wishes to thank the Examiner for having pointed out this issue. In response thereto, applicant has amended claims 9 and 18, and 6 and 15, since these latter claims have the same issue. No new matter has been added by these changes.

Claims 10-18 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since, referring to claim 10, and subsequently claims 11-18, the Examiner stated that applicant claims "a portable disk locator... with said means for identifying...", and that it is not clear if applicant intends this to refer to "said means for receiving". Applicant again wishes to thank the Examiner for having pointed out this obvious typographical error, and has amended claim 10 in accordance with the Examiner's suggestion. No new matter has been added by this change.

Claims 1-3, 6-12, 15-18 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Publication 2005/0144508 to McKean et al. in view of U.S. Patent No. 5,864,659 to Kini.

Further, claims 4, 5, 13, 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2005/0144508 to McKean et al. and US 5864659 to Kini as applied to claim 1 above, and further in view of U.S. Patent No. 5,305,013 to Daniels.

The McKean et al. reference has a common assignee and inventor with the above-identified application, as may be observed from the Assignment of Application therefor dated December 04, 2003 for the former patent application and the Assignment of Application dated March 25, 2004 for the latter patent

application. Since the reference constitutes prior art only under 35 U.S.C. 102(e) because the publication date was June 30, 2005, the rejection under 35 U.S.C. 103(a) can be overcome by disqualifying the McKean et al. reference under 35 U.S.C. 103(c)(1) which states: "... Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Therefore, applicants respectfully believe that the McKean et al. reference is not a proper reference for a rejection under 35 U.S.C. 103(a).

The Examiner has made certain prior art made of record, but has not applied these references to the subject claimed invention. As a result, applicant does not believe that further response is required with regard to these documents.

In view of the discussion presented hereinabove, applicant believes that subject claims 1-18, as amended, are in condition for allowance and such action by the Examiner at an early date is earnestly solicited.

Reexamination and reconsideration are respectfully requested.

Respectfully submitted,

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